

## REMARKS

### I. General

The outstanding issues in the instant application are as follows:

- Claims 1 – 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US2002/0116491 A1 by Boyd et al (hereinafter Boyd) in view of U.S. Patent No. 6,453,152 issued to Hong et al (hereinafter Hong).
- Claims 13 – 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyd.

Applicant has amended claim 1 by inserting the phrase “of said plurality of smart probes” to make it clear that the smart probes determines the conditions of said smart probes. This amendment does not alter the scope of the claim and has introduced no new matter.

Applicant has also amended claim 1 to correct an informality discovered during the preparation of this Amendment. Specifically, Applicant has amended claim 1 to recite “communicably” instead of “communicatably.” The amendment to claim 1 has introduced no new matter and does not alter the scope of the claim as a minor informality was corrected by the amendment.

Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1 – 34 are pending in the application.

### II. Rejections under 35 U.S.C. 103(a)

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claim 1

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Hong. Examiner concedes, “Boyd does not clearly teach or determines a set of conditions for said each one prior to said measuring.” Office Action, page 3. To address this deficiency in Boyd, Examiner asserts that Hong teaches “a method for measuring a base station’s performance in a mobile communication system that predetermined data before testing.” *Id.* Assuming, but not conceding, that this is the teaching of Hong, a combination of Hong and Boyd still does not teach all the limitations of claim 1.

Claim 1, as amended, recites, in part, “wherein each one of said plurality of smart probes determines a set of conditions for said each one of said plurality of smart probes prior to said measuring.” In contrast, Examiner asserts, “Hong teaches a method for measuring a **base station’s** performance.” Office Action, page 3. The distinction is that, in claim 1, the smart probe determines whether it is capable of performing the requested measurement while in Hong, as asserted by Examiner, the measurement means does not determine whether the measurement means can do the requested measurement, but rather, it determines the status of the base station. Office Action, page 3; *Hong*, 101, 103, Figure 2; col. 1 line 65 – col. 2, line 2. To make the distinction clearer, Applicant has amended claim 1, as described in the General section above. Therefore, a combination of Boyd and Hong, as cited by Examiner, does not teach all the limitations of claim 1.

In addition to not teaching all the limitations of claim 1, there is nothing in the applied art that teaches or suggests the combination asserted by the Examiner. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *In re Fritch*, 972 F.2d

1260, 23 USPQ2d 1780, 1783. Examiner has not cited to any part of Boyd or Hong that teaches or suggests the modification of Boyd by Hong. In fact, neither Boyd nor Hong, alone, in combination, or in what either or both could suggest in the related art, provides any teaching or suggestion supporting the combination of Boyd and Hong. *See generally Boyd; Hong*. Boyd is directed to “[a] method and system of evaluating the performance of a Web site by measuring site performance through the use of probing computers accessing the site ....” *Boyd*, Abstract. In contrast, Hong is directed to “[a] method for measuring a base station’s performance in a mobile communication system.” This difference between the inventions of Boyd and Hong indicates that one of ordinary skill in the art would not look to Hong in order to modify Boyd. The Examiner is not allowed to “use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 23 USPQ2d at 1784. Therefore, Examiner, in combining Boyd and Hong, is impermissibly using claim 1 as an instruction manual to piece together the alleged teachings of Boyd and Hong to render claim 1 obvious. *See Id.*

In sum, Boyd and Hong alone or in combination do not teach all the limitations of claim 1 or provide a suggestion or motivation for the modification of Boyd by Hong. Accordingly, Applicant respectfully requests that Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

B. Claims 2 – 12

Claims 2 – 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyd in view of Hong. Claims 2 – 12 depend from claim 1 and therefore inherit the limitations of claim 1. As discussed above, Boyd and Hong do not teach at least the limitation in claim 1 requiring “each one of said plurality of smart probes determines a set of conditions for said each one prior to said measuring” as recited in claim 1. Because claims 2 – 12 inherit this and all other limitations of claim 1, claims 2 – 12 are patentable. Accordingly, Applicant respectfully requests Examiner withdraw the rejection to claims 2 – 12 under 35 U.S.C. § 103(a).

### III. Rejections under 35 U.S.C. §102(b)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

#### A. Claims 13 and 24

Claims 13 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boyd. Claim 13 recites, “determining at said plurality of smart probes a set of tasks for completing said experiment.” Similarly, claim 24 recites, “means for determining at said plurality of smart probes a set of actions for completing said experiment.” Examiner cites to paragraphs [0015], [0022] and [0029] for these limitations in claims 13 and 24. However, the cited paragraphs do not teach at least these limitations of claims 13 and 24.

Specifically, paragraph [0015] of Boyd explains how a computer system acts as a probe. Paragraph [0022] describes how the internet can use several computer systems to analyze data. *See also* paragraphs [0020] and [0021]. Nowhere in Examiner’s citation to Boyd does it teach the computer systems, as probes, determine the set of tasks to complete an experiment. Paragraph [0029] outlines how the method can be tailored for particular needs. In Boyd, “[t]he **server** can ... **tailor the probe instructions** ....” Paragraph [0029], lines 6 – 7 (emphasis added). This is distinct from “determining at said plurality of smart probes ...” as recited in claims 13 and 24.

In sum, Boyd does not teach at least the limitation of claim 13 reciting, “determining at said plurality of smart probes a set of tasks for completing said experiment” and the limitation of claim 24 requiring “means for determining at said plurality of smart probes a set of actions for completing said experiment.” Accordingly, applicant respectfully requests that Examiner withdraw the rejections of claims 13 and 24 under 35 U.S.C. § 102(b).

#### B. Claims 14 – 23 and 25 – 34.

Claims 14 – 23 depend directly or indirectly from claim 13 and claims 25 – 34 depend directly or indirectly from claim 24. Each dependent claim inherits the limitations of their respective base claim and for at least this reason, claims 14 – 23 and 25 – 34 are patentable.

Accordingly, Applicant respectfully requests that Examiner withdraw the rejection to claims 14 – 23 and 25 – 34 under 35 U.S.C. § 102(b).

#### IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10030565-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 568240590US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: November 21, 2006

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